REMARKS

To further prosecution of the instant application, Applicant has amended herein Claims 2, 17, 42 and 49. Applicant respectfully requests reconsideration.

Applicant also has cancelled herein Claims 14, 26-27, 29, 37-38, 41, 44, and 79-80 without prejudice to the subject matter contained therein and with reservation to pursue the subject matter contained therein in one or more continuation and/or divisional application(s).

In addition, Applicant has added herein new Claims 81-88. New Claims 81-88 do not add subject matter and have antecedent basis.

Claims 2, 10-11, 13, 17, 40, 42, 43, 49, and 81-88 are currently pending with Claims 2, 42, 49, and 81 in independent form.

Rejection of Claims 79-80 Under 37 C.F.R. § 112

Claims 79-80 have been rejected under 37 C.F.R. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has cancelled herein claims 79-80 without prejudice to the subject matter contained therein and respectfully requests withdrawal of the rejection.

Rejection of Claims 2, 10, 11, 14, 17, 20, 26-27, 29, 37-38, 40-44, 49 and 79-80 Under 37 C.F.R. § 103

Claims 2, 10, 11, 14, 17, 20, 26-27, 29, 37-38, 40-44, 49 and 79-80 have been rejected under 37 C.F.R. § 103(a) as being unpatentable over U.S. 5,845,256 issued to Pescitelli (*Pescitelli)* in view of U.S. 6,584,446 issued to Buchanan (*Buchanan*) and in further view of "Benefits of Survivorship Life Insurance" by William Kistner (*Kistner*). As indicated above, Applicant has cancelled Claims 14, 26-27, 29, 37-38, 41, 44, and 79-80. Applicant respectfully traverses the rejection of the remaining pending Claims in view of the cited combination of prior art references for the reasons set forth below.

Applicant respectfully submits independent Claims 2, 42 and 49 are not obvious in view of the cited combination of prior art references to *Pescitelli*, *Buchanan* and *Kistner*. In addition, Applicant respectfully submits Claims 2, 42 and 49 are not obvious

in view of the prior art of record and, in particular, in view of the previously-cited reference "Manhattan Life Insurance Co.," Financial Services Week Abstract, August 24, 1992 (*Manhattan*), alone or in combination with any of the cited prior art references to *Pescitelli, Buchanan* and *Kistner*.

Applicant respectfully submits that the teachings of *Kistner* would not motivate one of ordinary skill in the art to modify *Pescitelli* and *Buchanan* to arrive at the invention of Claim 2, 42 or 49 because the cited combination would not achieve the invention specified in the Claim. More particularly, the cited combination would not achieve at least the limitation directed to, "the benefit qualification time frame . . . defining a predetermined period of time established in the insurance policy between the death of the one person and the death of the another person, as recited, for example, in Claim 2, because *Kistner* does not disclose any teaching or suggestion that would motivate one of ordinary skill to modify *Pescitelli* and *Buchanan* to include this limitation. The invention of Claim 2, 42 or 49 specifies that the benefit amount is paid only if simultaneous death of the persons occurs and/or death of both persons occurs "within the predetermined period of time of the benefit qualification time frame." In contrast, *Kistner* discloses a survivorship life insurance policy that insures two people that always pays a benefit after both persons die and upon the death of the second person. Under the policy of *Kistner*, the payment of the death benefit is certain and always paid upon the death of the second person regardless of when the death of the second person occurs after the death of the first person, while the payment of the benefit amount in accordance with the invention of Claim 2, 42 or 49 is uncertain and only paid upon simultaneous death of the persons and/or death of both persons "within the predetermined period of time of the benefit qualification time frame." *Kistner* therefore does not teach, suggest or motivate one of ordinary skill to modify *Pescitelli* and *Buchanan* to include the benefit qualification time frame that defines the predetermined period of time between the death of the one person and the death of the another person. Rather, *Kistner* teaches away from this limitation.

Further, Applicant respectfully submits that the teachings of previously-cited *Manhattan* would not motivate one of ordinary skill in the art to modify *Pescitelli* and *Buchanan*, or *Kistner, Pescitelli* and *Buchanan*, to arrive at the invention of Claim 2, 42

or 49 because the possible combinations of prior art with *Manhattan* would not achieve the invention specified in the Claim. More particularly, the possible combinations of art with *Manhattan* would not achieve at least the limitation directed to, "issuing the generated insurance policy without performing medical underwriting of the persons," as specified, for example, in Claim 2, because *Manhattan* does not provide a teaching or suggestion that would motivate one of ordinary skill to modify the possible combinations of art to include this limitation. *Manhattan* discloses a "first-to-die" life insurance policy with an optional simultaneous death benefit that pays a first benefit when the first person dies and pays a second benefit when the second person dies in accordance with the option. The *Manhattan* "first-to-die" policy provides for two risks - a certain risk of the death of the first person whereby the first benefit is always paid and an uncertain risk of the death of the second person whereby the second benefit is not always paid. *Manhattan* underwrites these risks for the "first-to-die" policy and is thereby in direct contrast to the limitation of Claims 2, 40 and 49 directed to generating the insurance policy without medical underwriting of the persons.

In addition, the possible combinations of prior art with *Manhattan* would not achieve the limitation directed to, "the payment of the death benefit amount being independent of the payment of one or more other insurance benefits either or both persons are eligible for," as recited, for example, in Claim 2. Rather, in contrast, *Manhattan* pays the second benefit amount only if the first person dies and the first benefit is paid, as is provided for under a conventional "first-to-die" policy. Therefore, the "first-to-die" policy *Manhattan* discloses provides for the payment of the second benefit depending on whether the payment of the first benefit is made. This teaching is in direct contrast to the noted limitation of Claim 2, 42, and 49.

Manhattan therefore does not teach, suggest or motivate one of ordinary skill in the art to modify any of the possible combinations of *Kistner*, *Pescitelli* and *Buchanan* to include those imitations of Claims 2, 42 and 49 discussed above. Rather, the "first-to-die" policy of *Manhattan* is in direct contrast to these claim limitations.

Thus, Claims 2, 42 and 49 are not obvious in view of the cited combination of prior art references or the prior art of record and are therefore patentably distinct.

Accordingly, Applicant respectfully requests withdrawal of the rejection of independent Claims 2, 42 and 49 under 37 C.F.R. § 103(a).

Claims 10, 11, 13, 17 and 40 depend from Claim 2 and are patentable for the reasons given above. In addition, Claim 43 depends on Claim 42 and is patentable for the reasons given above. Applicant therefore respectfully requests withdrawal of the rejection of dependent Claims 10, 11, 13, 17 and 40 under 37 C.F.R. § 103(a).

Patentability of New Claims 81-88

Applicant respectfully submits that new Claims 81-88 are patentably distinct over the cited combination of references and the prior art of record for one or more of the reasons given above.

Based upon the foregoing amendments and discussion, the instant application is in condition for allowance and an action to this effect is respectfully requested. Should Examiner Koppikar have any questions concerning this response, he is invited to telephone the undersigned.

The Commissioner is hereby authorized to charge any fees due to the deposit account of the undersigned, Deposit Account No. 50-0311, referencing Attorney Docket No. 07473-033.

Respectfully submitted,

Reg No 53097

Carol H. Peters
Registration No. 45, 010
Mintz Levin Cohn Ferris
Glovsky and Popeo, P.C.
Attorneys for Applicant
One Financial Center
Boston, MA 02111
Telephone: 617-348-4914
Facsimile: 617-542-2241
email: cpeters@mintz.com

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